

Attorney Docket No. 970232CIP/HG

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**



Applicant(s): Shu Jun Cheng et al.

Serial No. : 09/056,378

Filed : April 7, 1998

For : METHODS FOR TREATING
HYPERPLASIA

Art Unit : 1614

Examiner : R. Henley III

**TRANSMITTAL OF TERMINAL
DISCLAIMER FOR RECORDING**

Assistant Commissioner for Patents
Washington, D.C. 20231

S I R :

Please record the enclosed TERMINAL DISCLAIMER which
identifies Patent No. 5,795,911.

Please apply the enclosed check in the amount of \$110.00 in
payment of the fee for recording the TERMINAL DISCLAIMER.

Respectfully submitted,

A handwritten signature of Richard S. Barth in cursive script.

Richard S. Barth
Reg. No. 28,180

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Tel. No. (212) 319-4900
Fax No. (212) 319-5101
RSB/jh

Encs.: (1) Executed and dated TERMINAL DISCLAIMER
(2) Check for \$110.00

CERTIFICATE OF MAILING

I hereby certify this
correspondence is being
deposited with the United
States Postal Service as First
Class mail in an envelope
addressed to: Assistant
Commissioner for Patents,
Washington, D.C. 20231 on the
date noted below.

A handwritten signature of Richard S. Barth in cursive script.

Attorney: Richard S. Barth

Dated: April 29, 1999

In the event that this Paper
is late filed, and the
necessary petition for
extension of time is not filed
concurrently herewith, please
consider this as a Petition
for the requisite extension of
time, and to the extent not
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hereto, authorization to
charge the extension fee,
or any other fee required
in connection with this
Paper, to Account No. 06-1378.

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**MATRIX-CUSTOMER
SERVICE CENTER**

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Handwritten signature/initials and the number 6.

TERMINAL DISCLAIMER

The owners of a 100% interest in the above-identified
present application, namely the Assignees of record:

Assignees: Cancer Institute (Hospital), Chinese Academy
of Medical Sciences

05/05/1999 AIBRAHIM 00000070 09056378

01 FC:148

110.00 OP

Mitsui Norin Co., Ltd.

Assignment recorded on: April 7, 1998

Reel: 9088

Frame: 0322

hereby disclaims, except as provided below, the terminal part of
the statutory term of any patent granted on the above-identified
present application which extends beyond the full statutory term
defined in 35 USC 154 to 156 of the following commonly owned
patent:

Patent No.: 5,795,911 Issue Date: August 18, 1998 Filing Date: April 10, 1997

Any patent granted on the above-identified present application shall be enforceable only for and during such period that the patent granted on the above-identified present application is commonly owned with said commonly owned patent.

This Agreement is to run with any patent granted on the above-identified present application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, there is no disclaimer of the terminal part of any patent granted on the above-identified present application that would extend to the expiration date of the full statutory term as defined in 35 USC 154 to 156 of said commonly owned patent in the event that said commonly owned patent later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a Court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued or is in any manner terminated prior to the expiration of its full statutory term.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or

imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

ASSIGNEE: CANCER INSTITUTE (HOSPITAL)
CHINESE ACADEMY OF MEDICAL SCIENCES

Date: April 12, 1999

By: Zhiwei Dong
Name: Dong Zhi Wei
Title: Director

ASSIGNEE: MITSUI NORIN CO., LTD.

Date: April 21, 1999

By: Isao Nabae
Name: Isao Nabae
Title: President

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 5-13-99

APPL. S.N.: 091 056, 378

TO EXAMINER: R. Henley

ART UNIT: 1614

M. MONTGOMERY ROOM 1E18

MAILROOM DATE 5-3-99

AFTER FINAL YES ☐ NO ☒ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$_____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$_____. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)